

**REMARKS**

The Office Action of November 30, 2007, has been carefully reviewed, and in view of the following remarks, reconsideration and allowance of the pending claims is requested.

**Claim Rejections Under 35 U.S.C. §103(a)**

Claims 1-3 and 5-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Komatsu et al ("Komatsu", Japanese Patent 11-318985). The Official Action takes the position that Komatsu discloses each feature of Claim 1, except that Komatsu shows fixing tongues 7, 8 extending from both ends of the pad, rather than only the front end, as recited in the claim. However, the Official Action notes that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Komatsu such that a fixing tongue extends only from the front portion. The Office Action appears to rely on an "obvious to try" rationale.

Applicants respectfully traverse this rejection.

In order to meet the "obvious to try" standard, first, the *Graham* factual inquires must be resolved, then the following four factors must be satisfied:

- 1) a finding that at the time of the invention, there had been a recognized problem or need in the art, which may include a design need or market pressure to solve a problem,
- 2) a finding that there had been a finite number of identified, predictable potential solutions to the recognized need or problem,

- 3) a finding that one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success, and
- 4) whatever additional finding based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

See M.P.E.P. §2143, page 2100-134.

Applicant respectfully submits that basic *Graham* factual inquiries have not been resolved and the third element above has not been met, and for these reasons the rejection is improper.

The basic *Graham* factual inquiries require, *inter alia*, ascertaining the differences between the claimed invention and the prior art. In doing so, both the invention and the prior art reference are to be considered as a whole, including portions of the prior art that would lead away from the claimed invention. M.P.E.P. §2141.02, Part VI. When considered in its entirety, Komatsu teaches away from including at least one fixing tongue extending only from the front end of the pad. In the abstract of the translated Komatsu document, Komatsu addresses a problem of slippage and horizontal leaking between an absorptive article and a body fluid outflow part. Komatsu cures the issue by "forming both longitudinal ends into a length protruding outward from the body opening of the panties and forming an adhesive layer to be folded down and fixed to the outer surface." Thus, to prevent slippage and leaking, Komatsu requires a fastening device extending from both ends of the absorption device. This is illustrated in Figure 1 of Komatsu where the absorption device is shown having two fastening elements, or end flaps, 7, 8,

extending from both longitudinal ends of the device. The teachings of Komatsu, when considered in their entirety, would lead one of ordinary skill in the art to use two end flaps, one at each longitudinal end, to provide for firm attachment and immobilization of the pad. Komatsu never suggests using only one end flap. Modifying Komatsu to include an end flap only at the front end, as suggested in the Official Action, goes directly against Komatsu's teachings, and would preclude Komatsu's device from performing as intended.

With regard to the third element above, Applicants submit that a person of ordinary skill in the art would not have pursued known potential solutions with a reasonable expectation of success. The claimed arrangement is not a *known* potential solution. The only solution advanced by Komatsu, to prevent slippage and leaking, requires end flaps at both longitudinal ends to immobilize the pad. Using at least one fixing tongue at only the front end of the device is not contemplated by Komatsu. Nor would one of ordinary skill in the art have predicted that removing the rear end flap 8 would yield a solution to the problem of slippage and leaking, as such a modification goes against Komatsu's goal of immobilizing the device to achieve the desired result. Thus, providing at least fixing tongue extending only from the front end of the pad is not a known or predictable solution.

Additionally, a person of ordinary skill in the art would not have a reasonable expectation of success in modifying Komatsu. This is because Komatsu teaches away from modifying a pad to have at least one fixing tongue extending only from the front end portion of the pad, as addressed above. Komatsu addresses an issue of slippage and horizontal leaking, and overcomes the issue by implementing a second end flap 8 extending from the back end of the pad. Thus, to prevent slippage and

leaking, Komatsu requires a fastening device extending from both ends of the absorption device. Because Komatsu teaches the use of end flaps at both ends of the pad, one of ordinary skill would not have a reasonable expectation of success if they were to modify Komatsu to have a folding flap extending only from the front portion, as it would be expected that removal of one of the end flaps would lead to slippage and horizontal leaking. Accordingly, withdrawal of the rejection is respectfully requested.

With regard to Claim 4, Applicant cannot find where this claim was addressed in the most recent Official Action. Claim 4 recites that the entire fixing tongue comes to lie inside the edges of the absorbent part of the incontinence pad when the entire fixing tongue is folded over the liquid-permeable surface layer or the backing layer. Komatsu, in Figure 1, shows only a portion of a fixing tongue, or end flap, to lie within the edges of the absorbent part of the pad. The adhesive portion 10 on the fixing tongue is shown to surround the edge of the article of clothing in Figure 1, attaching itself to both an inner and outer portion of the article. Because at least a portion of the adhesive element 10 on each end flap is found within the article of clothing it is attached to, it is clear that only a portion of the fixing tongue lies within the absorbent pad, not the entire fixing tongue, as claimed.

In rejecting Claim 13, the Official Action relied on Komatsu's disclosure of first and second end flaps 7, 8 to meet the claimed feature of two fixing tongues. Applicants respectfully traverse this interpretation.

In rejecting Claim 1, from which Claim 13 depends, the Official Action took the position that it would have been obvious to construct the pad of Komatsu with an end flap extending only from the front end. In rejecting Claim 13, as noted above, first

and second end flaps 7, 8 are relied upon for showing two fixing tongues. However, the second end flap 8 extends from a rear portion of the pad. Thus, this interpretation of Claim 13 is at odds with the features recited in independent Claim 1, as this interpretation does not provide for at least one fixing tongue extending *only* from the front end of the pad. Accordingly, withdrawal of this rejection is respectfully requested.

In rejecting Claim 15, the Official Action took the position that Komatsu shows a second fastener 10 on the absorbent part. The Official Action indicates that the second fastener 10 is on the second end flap 8. For the reasons discussed above with regard to Claim 13, Applicants traverse this rejection. Similar to Claim 13, this claim also depends from Claim 1, which provides that at least one fixing tongue extends *only* from the front end of the pad. Here, reliance on the fastener 10 on the second end flap 8 is at odds with the features of Claim 1, because the second end flap 8 extends from a back or rear portion of the pad.

Alternatively, the proposed modification of Komatsu used in rejecting Claim 1, eliminates the back or rear end flap 8 from the pad. Because the second fastener 10 is located on the second end flap 8 to secure the end flap, elimination of the flap would also eliminate the second fastener. Thus, if the interpretation of Komatsu with regard to Claim 15 is inconsistent with the interpretation applied in the rejection of Claim 1. To the extent that a modification of Komatsu is proper to meet the provisions of Claim 1, which Applicants assert it is not, such an interpretation precludes the use of the second end flap 8 and the fastener 10 thereon. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 16 and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Komatsu in view of Mortez et al ("Mortez", U.S. Patent No. 5,291,617). The Official Action correctly notes that Komatsu does not teach the relative dimensions or shapes of the pad recited in Claims 16 and 17, but concludes that one of ordinary skill in the art would have been motivated to combine teachings of Mortez with Komatsu in order to permit an increased sense of dryness to the user. In making this rejection, the Official Action appears to rely the rationale that there is some teaching, suggestion, or motivation to combine references. Applicants respectfully traverse this rejection.

To reject a claim based on the above rationale, the *Graham* factual inquiries must be resolved, then the following three elements must be present:

- 1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings,
- 2) a finding that there was a reasonable expectation of success, and
- 3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

See M.P.E.P. §2143, pages 2100-138, 139.

Applicants respectfully submit that the basic *Graham* factual inquiries have not been resolved. The basic *Graham* factual inquiries require, *inter alia*, ascertaining the differences between the claimed invention and the prior art. In doing so, both the invention and the prior art reference are to be considered as a

whole, including portions of the prior art that would lead way from the claimed invention. MPEP §2141.02, Part VI. When considered in its entirety, Komatsu teaches away from including at least one fixing tongue extending only from the front end of the pad. In the abstract of the translated Komatsu document, Komatsu addressed a problem of slippage between an absorptive article and a body fluid outflow part. Komatsu addresses this issue of slippage by "forming both longitudinal ends into a length protruding outward from the body opening of the panties and forming an adhesive layer to be folded down and fixed to the outer surface." Thus, to prevent slippage, Komatsu requires a fastening device extending from both ends of the absorption device. This is illustrated in Figure 1 of Komatsu where the absorption device is shown having two fastening elements, or end flaps, 7, 8, extending from both longitudinal ends of the device. Modifying Komatsu to take the shape of Moretz goes against Komatsu's teaching that both longitudinal ends are to be formed into a length protruding outward from the body of the panties in order to prevent slippage of the pad.

With regard to the first element of the rationale discussed above, MPEP §2143.01, Part V, provides that when considering the suggestion or motivation to modify references, the proposed modification cannot render that prior art unsatisfactory for its intended purposes.

Modifying Komatsu such that the absorbent part or the pad is shaped like the wicking insert 32 in Moretz would render Komatsu unsatisfactory for its intended purpose, as this shape would eliminate at least the second end flap 8 that fastens to the back of the garment. Komatsu requires that both longitudinal ends be fastened

in order to prevent slippage or horizontal leakage. Accordingly, withdrawal of the rejections of Claims 16 and 17 is respectfully requested.

Claims 2, 3, 5-12, and 18 ultimately depend from Claim 1, which for the reasons discussed above, is allowable. For at least this reason, these claims are also allowable.

### CONCLUSION

In view of the above remarks, Applicant/s respectfully submit/s that the claims of the present application are now in condition for allowance, and an early indication of the same is earnestly solicited.

Should any questions arise in connection with this application or should the Examiner believe that a telephone conference would be helpful in resolving any remaining issues pertaining to this application; the Examiner is kindly invited to call the undersigned counsel for Applicant regarding the same.

Respectfully submitted,

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